

Remarks/Arguments:

I. Status

The Office Action dated May 24, 2005 (the "Office Action") has been carefully reviewed. Reconsideration of this application is respectfully requested.

II. The Rejection of Claims 1-17 under 103(a) Should be Withdrawn

In the Office Action, claims 1-17 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,662,166 B2 to Pare Jr. et al. (hereinafter "Pare") in view of U.S. Patent No. 6,202,151 B1 to Musgrave et al. (hereinafter "Musgrave"). The Applicants respectfully traverse.

Discussion Regarding Patentability of Claim 1

1. Claim 1

Claim 1 recites:

A system for providing consumer access to a financial account to implement a transaction comprising:

- a biometric data capture device for reading consumer biometric data; and
- a database server for generating a data storage key from the consumer biometric data received from the biometric data capture device and for retrieving a financial account data record corresponding to the generated data storage key.

Claim 1 thus recites a system with a database server operable to retrieve a financial account data record using a key generated from biometric data.

2. A Prima Facie Case Has Not Been Made

The Examiner has alleged that Pare discloses a biometric data capture device. (Office Action at page 3). Pare is not proper prior art with respect to the present invention.

The present application was filed on April 5, 2001. The application which resulted in the Pare patent was filed on June 11, 2001. Pursuant to 35 U.S.C. § 103, the obviousness of a patent claim is determined "at the time the invention was made." Therefore, because the application which ripened into the Pare patent was not filed until *after* the present application was filed, Pare is not prior art as to the present application.¹

Accordingly, because Musgrave has not been alleged to include a biometric data capture device, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of claim 1. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claim 1.

3. The Basis of the Rejection is Not Clear

Moreover, the Examiner has not clearly set forth the basis of the rejection of the present claims as required by the MPEP. MPEP § 707.07(d) states that "[w]here a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated." The basis of the Examiner's rejections is/are not clear.

¹ Applicants note that Pare is a continuation of an application that was filed on January 29, 1999 and which ultimately issued as U.S. patent no. 6,269,348 B1 (hereinafter the '348 patent"). The portions of Pare relied upon by the Examiner do not have identical corresponding disclosure in the '348 patent. Therefore, Pare is not proper prior art.

Specifically, the rejection has been postured as an obviousness-type rejection based upon the combination of Pare and Musgrave. (See Office Action at page 2). Generally, this type of rejection relies upon two or more references for teaching all of the elements in a claim. Moreover, it appears that an obviousness-type rejection is intended since, using claim 1 as an example, in a previous Office Action the Examiner has admitted that Pare does not teach all of the elements of claim 1. (Office Action dated October 8, 2004, p. 6).

The confusion arises, however, since the Office Action identifies portions of Pare as teaching all of the elements of claim 1. This is more consistent with an anticipation rejection, particularly in light of the fact that the proposed modification of Pare appears to involve an element that is not recited in claim 1.

Accordingly, in the event that the Examiner maintains the rejection of claims 1-17, clarification of the basis for the rejection is respectfully requested. In an attempt to move the application forward, however, the Applicants' have attempted to respond to the Examiner's rejections to the extent possible.

4. There is No Motivation to Combine the References

The Examiner appears to have acknowledged that Pare does not disclose all of the elements of claim 1. (Office Action at page 3). The Examiner has apparently alleged that Musgrave discloses the elements of claim 1 not disclosed in Pare and that the motivation to modify Pare with Musgrave lies in the desire for "security as well as accuracy as well as reduction of computational resources." (Id. at page 3). Respectfully, the Examiner has failed to provide sufficient authority for the foregoing allegations.

Specifically, the Federal Circuit has stated that “[the] factual question of motivation is material to patentability, and [cannot] be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002)(internal citations omitted). Significantly, the Federal Circuit in *In re Lee* determined that an examiner’s conclusory statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” did not adequately address the issue of motivation to combine. (*Id.* at 1343).

Similarly, in the rejection of claim 1, the Examiner has made conclusory statements but has not identified any art that discusses how a “creating a hash value” as taught by Musgrave (as alleged in the Office Action at page 3) provides better security, accuracy or reduction of computational resources in a system as disclosed by Pare.

Therefore, the Examiner has not set forth a sufficient basis or identified a proper source for the proposed motivation to combine the teachings of Pare with the teachings of Musgrave. Therefore, under MPEP § 2143.01, the Examiner has failed to present a *prima facie* case of obviousness and the rejection of claim 1 under 35 U.S.C. 103(a) should be withdrawn

5. Pare Has Been Mischaracterized

As stated in the Office Action, the Examiner rejected claim 1 based upon the proposition that Pare disclosed a database server operable to retrieve a financial account data record using a key generated from biometric data. (Office Action at page 3). Pare has been mischaracterized.

Specifically, the Examiner has alleged that Pare discloses such a data base server at “figure 2 and 3 and associated text, column 4, lines 34-37, column 5, lines 15-55, column 6, lines 67-13 (sic) and lines 47-54, and column 9, lines 54-58.” (Office Action at page 3). A review of Pare, however, reveals that the Examiner has committed the same mistake that was discussed in the Applicants’ last Amendment. Namely, the Examiner has erroneously equated “verifying the identity of an individual” with “identifying a financial account.”

FIG. 2 shows a “party identifying apparatus” (PIA). As described at column 7 line 54 through column 8 line 63 of Pare, the PIA 1 is merely a sensor device for obtaining biometric data. There is no discussion of using any biometric data obtained with the PIA to generate a key used to obtain a financial account record. Rather, the device is used merely to provide biometric data which is used by an identification module to identify the *individual* attempting to complete a transaction. (Pare at column 10, lines 3-5). Fig. 3 as described at column 9, lines 44-47 of Pare modifies the system of FIG. 2 by including the use of a cellular digital packet data. Accordingly, FIGs. 2 and 3 of Pare do not disclose a database server as recited in claim 1.

At column 4, lines 34-37, Pare merely states that an object of the invention is to eliminate the use of personal identification numbers in accessing a financial account. A

stated objective is not a disclosure of a particular manner in which to accomplish the objective. Accordingly, this citation of Pare does not support the rejection of claim 1.

At column 5, lines 15-55, Pare clearly states that the invention disclosed therein “identifies the payor.” (Pare at column 5, lines 18-19). A *payor* is not a financial *account*. Accordingly, this section of Pare does not disclose retrieving a financial account data record using a key generated from biometric data.

At column 6, lines 7-13 and lines 47-54, Pare discloses that an object of the invention is to provide a person with simultaneous direct access to financial accounts. A stated objective is not a disclosure of a particular manner in which to accomplish the objective. Accordingly, these citations of Pare do not support the rejection of claim 1.

At column 9, lines 54-58, Pare discloses that the data processing centers retrieve financial account information “for identified parties.” Once again, however, there is no disclosure of *how* the retrieval of the financial documents are retrieved, only that such retrieval occurs after identification of the individual using the biometric data.

Accordingly, Pare clearly discloses the use of biometric data to identify an individual. Pare fails, however, to disclose using a key generated from biometric data to retrieve a financial account data record. An individual is not a financial account.

Therefore, even if Pare is modified to include the use of Musgrave’s concatenator, the modification does not arrive at invention of claim 1. Therefore, under MPEP § 2143.03, the Examiner has failed to present a *prima facie* case of obviousness and the rejection of claim 1 under 35 U.S.C. 103(a) should be withdrawn.

6. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the rejection of claim 1 as being obvious over Pare in view of Musgrave has been successfully traversed, and the Applicants respectfully submit that the rejection of claim 1 under 35 U.S.C. § 103 should be withdrawn.

Discussion Regarding Patentability of Claim 3

The Examiner has rejected claim 3 based upon the same combination of prior art and the same arguments discussed above with respect to claim 1. Claim 3 is an independent claim which recites “a payment device for sending said captured biometric data to a merchant payment host as the identifier for the consumer’s financial account data.” For the same reason set forth above with respect to claim 1, a biometric data identifier identifying a financial account is not the same as identifying an individual using biometric data. That is, an individual is not a financial account. Therefore, for at least the same reasons set forth above with respect to claim 1, claim 3 is allowable over the prior art.

Discussion Regarding Patentability of Claim 2 and 4

The Examiner has rejected claims 2 and 4 based upon the same combination of prior art and the same arguments discussed above with respect to claims 1 and 3, respectively. Claims 2 and 4, as amended, depend from claims 1 and 3, respectively. Therefore, for at least the same reasons set forth above with respect to claims 1 and 3, claims 2 and 4, respectively, are allowable over the prior art.

Discussion Regarding Patentability of Claim 6

The Examiner has rejected claim 6 based upon the same prior art combination discussed above with respect to claim 1. (Office Action at page 2). Claim 6 recites a system with a database server operable to retrieve data records using a key generated from biometric data. This is similar to the recitation of claim 1 discussed above. Thus, for at least the same reasons set forth above with respect to claim 1, claim 6 is allowable over the prior art.

Discussion Regarding Patentability of Claim 7

The Examiner has rejected claim 7 based upon the same combination of prior art and the same arguments discussed above with respect to claim 6. (Office Action at page 3). Claim 7 depends from claim 6 and includes all of the limitations of claim 6. Therefore, for at least the same reasons set forth above with respect to claim 6, claim 7 is allowable over the prior art.

Discussion Regarding Patentability of Claim 8

The Examiner has rejected claim 8 based upon the same prior art combination discussed above with respect to claim 1. (Office Action at page 2). Claim 8 recites a method of retrieving a financial data record stored in a memory using a data storage key generated from biometric data. This is similar to the recitation of claim 1 discussed above. Thus, for at least the same reasons set forth above with respect to claim 1, claim 8 is allowable over the prior art.

Discussion Regarding Patentability of Claims 9-11

The Examiner has rejected claims 9-11 based upon the same combination of prior art and the same arguments discussed above with respect to claim 8. (Office Action at page 4). Claims 9-11 depend directly or by way of an intermediate claim from claim 8 and include all of the limitations of claim 8. Therefore, for at least the same reasons set forth above with respect to claim 8, claims 9-11 are allowable over the prior art.

Discussion Regarding Patentability of Claim 13

The Examiner has rejected claim 13 based upon the same prior art combination discussed above with respect to claim 1. (Office Action at page 2). Claim 13 recites a method of retrieving a financial record that is identified, at least in part, by previously captured biometric data using biometric data. This is similar to the recitation of claim 1 discussed above. Thus, for at least the same reasons set forth above with respect to claim 1, claim 13 is allowable over the prior art.

Discussion Regarding Patentability of Claim 14

The Examiner has rejected claim 14 based upon the same combination of prior art and the same arguments discussed above with respect to claim 13. (Office Action at page 4). Claim 14 depends from claim 13 and includes all of the limitations of claim 13. Therefore, for at least the same reasons set forth above with respect to claim 13, claim 14 is allowable over the prior art.

Discussion Regarding Patentability of Claim 15

The Examiner has rejected claim 15 based upon the same prior art combination discussed above with respect to claim 1. (Office Action at page 2). Claim 15 recites a method of retrieving a financial data record stored in a memory using a data storage key generated from biometric data. This is similar to the recitation of claim 1 discussed above. Thus, for at least the same reasons set forth above with respect to claim 1, claim 15 is allowable over the prior art.

Discussion Regarding Patentability of Claims 16-17

The Examiner has rejected claims 16-17 based upon the same combination of prior art and the same arguments discussed above with respect to claim 15. (Office Action at page 4).² Claims 16-17 depend directly from claim 15 and include all of the limitations of claim 15. Therefore, for at least the same reasons set forth above with respect to claim 15, claims 16-17 are allowable over the prior art.

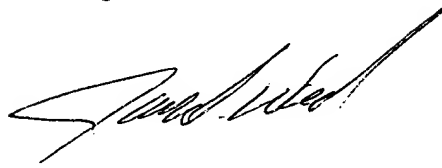
² There is no specific discussion of claim 17, however, claim 17 is allowable at least for the reasons set forth above. In the event the Examiner maintains the rejection of claim 17, the Applicants respectfully request the Examiner identify the portion of the prior art that discloses the additional elements of claim 17.

VI. Conclusion

Applicants respectfully request favorable consideration of the application in view of the foregoing remarks.

A prompt and favorable action on the merits is requested.

Respectfully Submitted,
Maginot, Moore & Beck

A handwritten signature in black ink, appearing to read "James D. Wood", written over a horizontal line.

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